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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,125	10/10/2003	Xiao Zhang	ROC920030245US1	2745
46797 7590 03/16/2011 IBM CORPORATION, INTELLECTUAL PROPERTY LAW DEPT 917, BLDG. 006-1 3605 HIGHWAY 52 NORTH ROCHESTER, MN 55901-7829				
EXAMINER				
DAGNEW, SABA				
ART UNIT		PAPER NUMBER		
3688				
MAIL DATE		DELIVERY MODE		
03/16/2011		PAPER		

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1 UNITED STATES PATENT AND TRADEMARK OFFICE  
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4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6  
7

8 *Ex parte* XIAO ZHANG  
9

10 Appeal 2010-004080  
11 Application 10/684,125  
12 Technology Center 3600  
13  
14

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16  
17 Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and  
18 ANTON W. FETTING, *Administrative Patent Judges*.  
19 FETTING, *Administrative Patent Judge*.

20 DECISION ON APPEAL<sup>1</sup>  
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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE<sup>2</sup>

Xiao Zhang (Appellant) seeks review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-15 and 33-43, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellant invented a method and system for identifying products available for sale based on a configured order. Specification ¶ 0001.

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A computer-implemented method of cross-selling products based on a system for sale to a customer, comprising:

[1] for each selection by a user of a product from a product information source, receiving an order representing a state of a system based on the user selections; and

[2] in response to receiving each order configuring one or more computer processors of an analyzer with instructions that transform the one or more computer processors into cross-sell logic configured to perform an operation comprising:

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<sup>2</sup> Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed August 14, 2009) and Reply Brief ("Reply Br.," filed December 22, 2009), and the Examiner's Answer ("Ans.," mailed November 12, 2009), and Final Rejection ("Final Rej.," mailed April 16, 2009).

[a] determining whether the order qualifies for one or more cross-sell products; and

[b] if so, presenting the one or more cross-sell products to the user, wherein each of the one or more cross-sell products presented to the user is offered at a discount based on the state of the system, and wherein each of the one or more cross-sell products presented to the user is determined to be compatible with the state of the system.

The Examiner relies upon the following prior art:

Henson                      US 6,167,383              Dec. 26, 2000

Claims 1-15 and 33-36 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Henson.

Claims 37-43 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Henson.

## ISSUES

The issue of whether the Examiner erred in rejecting claims 1-15 and 33-36 under 35 U.S.C. § 102(b) as being anticipated by Henson turns on whether Henson describes the features of limitation [2][b] of claim 1 and as they are recited in claim 33.

The issue of whether the Examiner erred in rejecting claims 37-43 under 35 U.S.C. § 103(a) as unpatentable over Henson turns on whether a person with ordinary skill in the art would have been motivated to modify Henson.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

*Facts Related to the Prior Art*

*Henson*

01. Henson is directed to an online store user interface for enabling custom configuration, pricing, and ordering of a computer system via the Internet. Henson 1:18-21. Henson is concerned with the improved accuracy, reliability, and overall quality of an online store and the buying experience for customers. Henson 2:55-58.

02. Henson describes that the online store includes a welcome page, a configurator page, a cart, a checkout, and a thank you page. Henson 5:6-7. A customer can build a configured machine by selecting options listed on the configuration screen. Henson 6:18-21. Merchandising recommendations are provided to the customer during the customer's custom building of a particular system. Henson 7:22-25. Merchandising recommendations are provided in response to particular choices being made by the customer during the configuring of a custom computer system. Henson 7:31-36. The shopping cart further includes space for displaying merchandising messages to a customer in order to take advantage of up-sell and cross-sell opportunities. Henson 9:40-44. The entry of a text message in the store database triggers the presentation of the merchandising or information content on the shopping cart web page. Henson 9:44-47. Merchandising

1 recommendations in the shopping cart can be provided based upon  
2 the contents of the shopping cart, where there is something that  
3 could be recommended as an upgrade or a cross-sell. Henson  
4 9:56-60. Passive messaging can also be used, where passive  
5 messages are displayed during a particular time or any other  
6 information not directly connected to the contents of the shopping  
7 cart. Henson 10:1-8. During checkout, a customer is asked  
8 whether the customer is a previous customer and what that  
9 customer's customer number is. Henson Fig. 7.

10 03. The system configuration page includes McAfee VirusScan 3.1  
11 at no additional charge. Henson Fig. 3A. McAfee VirusScan 3.1  
12 is specific to the operation system, such as Microsoft Windows 95  
13 or 98. Henson Fig. 3A. A view all system options view lists the  
14 price of the corresponding products in relation to each other.  
15 Henson Fig. 5. For example, the cost of SDRAM is organized by  
16 quantity and price in relation to the cost of 96MB. Henson Fig. 5.

17 04. The system further includes both passive and active validation,  
18 where passive validation is the validation module knowing that  
19 specific options don't work together whereas active validation  
20 cross-checks the options of the configuration and indicates the  
21 occurrence of a problem when a problem is detected. Henson  
22 10:56-65. Validation includes a cross-checking of a combination  
23 of options and determines whether a particular combination of  
24 options can be physically built. Henson 8:34-37.

ANALYSIS

*Claims 1-15 and 33-36 rejected under 35 U.S.C. § 102(b) as being  
anticipated by Henson*

The Appellant first contends that Henson fails to describe presenting one or more cross-sell products to a user, wherein each of the one or more cross-sell products presented to the user is offered at a discount based on the state of the system, as required by limitation [2][b] of claim 1 and as recited in claim 33. App. Br. 12-13 and 15. The Appellant argues that the Examiner is relying on inherency in rejecting this claim limitation. App. Br. 13. The Appellant also argues that the Examiner's definition of "discount price" is flawed. Reply Br. 3. We disagree with the Appellant. Limitation [2][b] only requires presenting a cross-sell product to the user based on the system and offering that cross-sell product at a discount. The plain and ordinary meaning of a "discount" encompasses any price or value that is less than the originally offered price. There is no requirement in the claim language that precludes a construction of a discount from being free or at no cost. Henson describes that McAfee VirusScan is offered to a user when the user has selected a system with the corresponding operating system, such as Microsoft Windows 95 or 98. FF 03. In this example, McAfee VirusScan is a cross product to the configured computer system. Henson also describes that McAfee is offered for no additional charge to the user. FF 03. As such, Henson describes that this software program is offered at a discount within the plain and ordinary meaning of the term discount. As such, Henson explicitly describes this limitation and the Examiner is not relying on inherency. The Appellant also argues that the Examiner mistakenly equates a discount price with being entirely free because a free item has no price.

1 However, claims do not require any specific price to be associated with the  
2 discount. Since Henson describes software that is offered at no additional  
3 cost, the Examiner's construction of a discount to encompass no additional  
4 charge to a user is both reasonable and consistent with the claimed  
5 invention.

6 The Appellant also contends that Henson fail to describe that each of the  
7 one or more cross-sell products presented to the user is determined to be  
8 compatible with the state of the system, as also required by limitation [2][b]  
9 of claim 1. The Appellant argues that since Henson does not describe this  
10 feature, the Examiner is relying on inherency in rejecting this claim  
11 limitation. App. Br. 14. We disagree with the Appellant. Henson describes  
12 that the system uses both passive and active validation. FF 04. Active  
13 validation cross-checks the options of the configuration and indicates the  
14 occurrence of a problem when a problem is detected. FF 04. Henson further  
15 describes a validation that cross-checks the combination of options and  
16 determines whether a particular combination is structurally compatible with  
17 the system. FF 04. As such, Henson describes validating that cross-sell  
18 products are determined to be compatible or incompatible with the state of  
19 the system.

20 The Appellant further contends that the Examiner has failed to address  
21 the limitation determining a discount value "based on the user selections of  
22 one or more component products" and therefore has failed to properly  
23 establish the rejection of claim 33. App. Br. 14. We disagree with the  
24 Appellant. Claim 1 is distinguished from claim 33 on this limitation because  
25 claim 1 requires the discount is "based on the state of the system."  
26 However, the Specification consistently uses the term "state of the system"



1 to encompass the configuration of the system based on product selections.  
2 Specification ¶ 0009. As such, the scope of the limitations “based on the  
3 user selections of one or more component products” and “based on the state  
4 of the system” is functionally the same. As discussed *supra*, Henson  
5 describes determining a discount based on the state of the system or a user’s  
6 selection of components. As such, the Examiner’s rejection of this claim  
7 limitation is sustained.

8 The Appellant additionally contends that Henson fails to describe “one  
9 or more software wizards to assist the user in configuring the configured  
10 system” as required by claim 33. App. Br. 15. The Appellant specifically  
11 argues that the term “software wizard” refers to a user interface configured  
12 to aid a user in performing a defined task. App. Br. 15. We disagree with  
13 the Appellant. The Specification does not to provide a specific definition for  
14 the term “software wizard” and the claims fail narrow the definition of a  
15 “software wizard.” The Examiner construed this term to encompass the  
16 functional steps performed by software modules to configure, price, validate,  
17 and cross-sell merchandizing. Ans. 6. This construction of the term  
18 “software wizard” is both reasonable and consistent with the Specification.  
19 Henson explicitly describes assisting a user in product selections by enabling  
20 a user to select or configure a product, provides the price of each of the  
21 components, validates whether the selected components are compatible, and  
22 sends messages to user for cross-sell and up-sell options. FF 02-04. As  
23 such, the Appellant’s argument is not found to be persuasive.

24

*Claims 37-43 rejected under 35 U.S.C. § 103(a) as unpatentable over  
Henson*

The Appellant contends that there is no motivation to modify Henson to include a feature to receive a second configured system based on a previous order from the same user. App. Br. 16-17. We disagree with the Appellant. Henson describes maintaining a customer set list and assigning previous customers to a specific customer number. FF 02. As such, Henson implicitly describes associating orders to the customer and maintaining the customer's information in a database. Henson is concerned with the overall buying experience for a customer and a feature to allow a customer to repeat a previously submitted order or base a new order on a previously submitted order enhances the customer's buying experience. As such, a person with ordinary skill in the art would have been motivated to modify Henson to include this feature in order to enhance the buying experience. Therefore, a person with ordinary skill in the art would have found it obvious to modify Henson.

**CONCLUSIONS OF LAW**

The Examiner did not err in rejecting claims 1-15 and 33-36 under 35 U.S.C. § 102(b) as being anticipated by Henson.

The Examiner did not err in rejecting claims 37-43 under 35 U.S.C. § 103(a) as unpatentable over Henson.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 1-15 and 33-36 under 35 U.S.C. § 102(b) as being anticipated by Henson is sustained.
- The rejection of claims 37-43 under 35 U.S.C. § 103(a) as unpatentable over Henson is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

MP

Address

IBM CORPORATION, INTELLECTUAL PROPERTY LAW  
DEPT 917, BLDG. 006-1  
3605 HIGHWAY 52 NORTH  
ROCHESTER MN 55901-7829